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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,073	02/15/2001	Yoshinori Ito	35.C15126	3810

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EXAMINER
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HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/783,073

**Applicant(s)**

ITO, YOSHINORI

**Examiner**

Calvin L Hewitt II

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 33-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-17 and 33-37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12-1-04</u> . | 6) <input type="checkbox"/> Other: _____  |

***Status of Claims***

1. Claims 1-17 and 33-37 have been examined.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 37 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 37 is directed to computer code stored on a medium. Computer code is non-functional and when nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance (In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978)) (MPEP 2106-11 IV B 1).

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6, 8, 9-13, 15, 17 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "wherein said information based on the output image" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites "wherein said addition means adds information specific to the apparatus". Claim 1, from which claim 8 depends, recites an image processing apparatus and an information communication apparatus, therefore it's not clear to which apparatus claim 8 is referring.

The preamble of claim 9 recites an image processing apparatus *capable* of communicating with an external server. The word "capable" does not indicate whether or not the apparatus and server are connected, only that it is possible. Hence, it is not clear whether or not the external server receives output from the "second output means". Claims 13 and 15 contain similar language.

Claims 10-12 are rejected as they depend from claim 9.

Claim 9 recites the limitation "said information on the address of fee billing according to a result of identification..." in lines 11 and 12. Claim 9 also recites "the output image from said image processing apparatus" in lines 15-17 and "the output of said image" in lines 18-19. Claims 13 and 17 also contain the above language. There is insufficient antecedent basis for this limitation in the claims.

Claims 10-12 are also rejected as they depend from claim 9.

Claim 33 recites the limitation "to the exterior" in line 5. There is insufficient antecedent basis for this limitation in the claims.

Claim 33 recites embedding information "in case" without providing one of ordinary skill how the apparatus is to perform in the alternative case.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 3, 5, 7, 14, 16, and 33-37 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Holmes et al., U.S. Patent No. 6,119,108.

As per claims 1, 3, 5, 7, 14, 16, and 33-37, Holmes et al. teach an image processing apparatus comprising:

- first input means for entering information on an addressee of fee billing from said information communication apparatus (column 5, lines 25-32)
- second input means for entering an image (column 4, lines 58-64)
- addition means for adding said information on the addressee of fee billing to said image in a manner not easily recognizable to human eyes and outputting said image (column 6, lines 51-59)
- information such as information that specifies credit card company and credit card user (column 5, lines 25-32)
- first input means for entering information for enabling activation (column 5, lines 60-66) and second input means also for enabling activation in response to the entering of enabling information (abstract)
- discrimination means for discriminating whether said image is a specified image and control means for controlling the addition by said addition means based on the result of discrimination by discrimination means (column 5, lines 25-58)

- inquiry means for authenticating predetermined information by communicating through a communication channel with an external server (column 5, lines 32-44)

8. Claims 9, 10, 12, 15, and 17 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Krishnan et al., U.S. Patent No. 6,073,124.

As per claims 9, 10, 12, 15, and 17, Krishnan et al. teach an information communication apparatus comprising:

- a first input means for entering information on an addressee of fee billing (e.g. credit card information specifying a company and a user) and a password (figures 14 and 15)
- first output means for outputting said information to an external server (figures 3 and 12; column 19, lines 45-60; column/line 20/64-21/2)
- second output means for outputting to an image processing apparatus information on the address of fee billing according to a result of identification on said information on the addressee of fee billing and said password in said external server (figure 12; column 19, lines 63-67)
- second input means for entering information and third output means for outputting information to said external server (figure 17)
- second output means for enabling activation of said image processor (column/line 8/65-9/7; column 19, lines 63-67)

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes et al., U.S. Patent No. 6,119,108 in view of May, U.S. Patent No. 6,021,492.

As per claim 2, Holmes et al. teach a system for protecting content using a communication apparatus (i.e. plug-in embodied in a computer) that controls the use of software on a user computer (column 5, lines 15-53). However, Holmes et al. do not specifically recite outputting information to the communication apparatus based on an outputted image. May teaches content protection by limiting the number of access a user has to content (figures 11-14). Specifically, May teaches outputting information to a content control module based on outputted content (figures 10-15; column/line 9/58-11/67). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Holmes et al. and May in order to allow content creators to allow users to try content before purchasing and to provide users with other compensatable methods for accessing content other than buying (column/line 9/58-11/52).



10. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes et al., U.S. Patent No. 6,119,108.

As per claim 4, Holmes et al. teach a first input means for entering credit card information on an addressee of fee billing from said information communication apparatus (column 5, lines 25-32). Holmes et al. do not teach debit card information. However, it is well known to those of ordinary skill in electronic commerce to pay for goods and services using a debit card, therefore, it would have been obvious to allow content consumers to pay for content using a debit card (figure 2).

As per claim 6, Holmes et al. teach outputting content using a computer (figure 2). Computers that control output based on paper size or color are old and well known.

11. Claims 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes et al., U.S. Patent No. 6,119,108 in view of Chou et al., U.S. Patent No. 5,337,357.

As per claim 8, Holmes et al. teach a first input means for entering information from said information communication apparatus (column 5, lines 25-32). However, Holmes et al. do not specifically recite entering apparatus information. Chou et al. teach a method for protecting content using input information such as an apparatus identifier (abstract; figure 1). Therefore, it

would have been obvious to one of ordinary skill to combine the teachings of Holmes et al. and Chou et al. in order to use personal information such as user computer-specific information to protect content ('108, column 5, lines 29-31; '357, figure 1).

12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al., U.S. Patent No. 6,073,124.

As per claim 11, Krishnan et al. teach a first input means for entering credit card information on an addressee of fee billing from said information communication apparatus (figures 14-17). Krishnan et al. do not teach debit card information. However, it is well known to those of ordinary skill in electronic commerce to pay for goods and services using a debit card, therefore, it would have been obvious to allow content consumers to pay for content using a debit card (figures 14-17).

13. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes et al., U.S. Patent No. 6,119,108 in view of Krishnan et al., U.S. Patent No. 6,073,124.

As per claim 13, Holmes et al. teach an image processing apparatus comprising:

- first input means for entering information on an addressee of fee billing from said information communication apparatus (column 5, lines 25-32)
- second input means for entering an image (column 4, lines 58-64)
- addition means for adding said information on the addressee of fee billing to said image in a manner not easily recognizable to human eyes and outputting said image (column 6, lines 51-59)

However, Holmes et al. do not specifically recite a first input means for entering information on an addressee of fee billing (e.g. credit card information specifying a company and a user) and a password. Krishnan et al. teach an information communication apparatus comprising:

- a third input means for entering information on an addressee of fee billing (e.g. credit card information specifying a company and a user) and a password (figures 14 and 15)
- third output means for outputting said information to an external server (figures 3 and 12; column 19, lines 45-60; column/line 20/64-21/2)
- fourth output means for outputting to an image processing apparatus information on the address of fee billing according to a result of identification on said information on the addressee of fee billing and said password in said external server (figure 12; column 19, lines 63-67)

- fourth input means for entering information and fifth output means for outputting information to said external server (figure 17)

Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Holmes et al. and Krishnan et al. in order to authenticate user purchases ('108, column 5, lines 34-44; '124, figures 12-17, column 19, lines 20-67).

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
- Stefik et al. teach a method and system for controlled printing using watermarks

15. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

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Art Unit: 3621

c/o Technology Center 2100

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or faxed to:

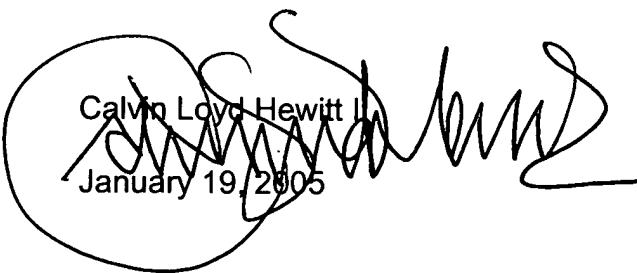
(703) 305-7687 (for formal communications intended for entry and  
after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application  
should be directed to the Group receptionist whose telephone number is (703)  
308-1113.

  
Calvin Lloyd Hewitt II  
January 19, 2005